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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,062	10/09/2003	Jay S. Walker	02-034	8164
22927 7590 04/09/2010 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
PIERCE, DAMON JOSEPH				
ART UNIT		PAPER NUMBER		
3714				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/682,062

Applicant(s)

WALKER ET AL.

Examiner

DAMON PIERCE

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/226)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The examiner acknowledges the amendments of claims filed on 1/13/2010. Currently, claims 1-48 are cancelled. Claims 49-69 are newly added and pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 49-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims include the following recitations which lack proper support in the original specification and are deemed new matter:

- "regulatory authority";
- "expiration condition";
- (claim 49) "only if the expiration condition has not yet been met, allowing play of the wagering game with the particular feature" (emphasis added); and
- (claim 59) "only if the expiration condition has not yet been met, allowing play of the wagering game on the particular gaming device" (emphasis added);
- (claim 69) that a wagering game has been mandated by a regulatory authority to only be played while a specified feature is enabled; receiving an

authorization code from a gaming operator operating the wagering game, the authorization code indicating whether the wagering game has only been allowed to be played while the feature was enabled; and verifying, by a processor and by decrypting the authorization code, that the wagering game has only been allowed to be played while the feature was enabled (emphasis added);

- (claims 51 and 61) "the expiration condition is a maximum number of plays of the wagering game for which the authorization code is valid";
- (claims 52 and 62) "the expiration condition is a maximum sum of wagers for which the authorization code is valid";
- (claims 53 and 63) "prior to allowing play of the wagering game, confirming via the processor that an authorization code disallowing play of the wagering game has not been received from the regulatory authority"; and
- Please note that although not stated verbatim: the claim limitations for claims 54-58 and 64-68 are also deemed new matter.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 49 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 includes the recitation, "prior to allowing play of a wagering game including a particular feature and via a processor of a device operable to facilitate the

wagering game, determining whether an authorization code for enabling play of the wagering game with the particular feature has been received from a regulatory authority" (emphasis added), is unclear because the claim does not clearly state whether the allowing of a wagering game is accomplished via the processor or by a person.

Claim 69 includes the recitation, "receiving an authorization code from a gaming operator operating the wagering game, the authorization code indicating whether the wagering game has only been allowed to be played while the feature was enabled" (emphasis added), where it is unclear as to who/what is "receiving an authorization code", and in addition, whether the "gaming operator" is a machine or person.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 49-58 and 69 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter because these are method and process claims that do not transform underlying subject matter (such as an article or materials) to a different state or thing, nor are they tied to another statutory class (such as a particular machine). See *Diamond v. Diehr*, 450 U.S. 175, 184, (1981) (quoting *Benson*, 409 U.S. at 70); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978) (citing *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). See also *In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007) (request for rehearing en banc pending).

Specifically, the claims fail to identify the apparatus that accomplishes the method steps of "allowing play" and "receiving an authorization code", in this case, there is no apparatus positively stated in the claims that allows game play and receives authorization codes, thus the claimed steps as currently presented can be done by a person or by hand.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 49-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Giobbi (US 6,749,510).

Regarding claims 49, 59, Giobbi discloses **a method for facilitating play of a wagering game on a gaming device** (see Figs. 1 and 2), comprising:

prior to allowing play of a wagering game including a particular feature and via a processor of a device operable to facilitate the wagering game, determining whether an authorization code for enabling play of the wagering game with the particular feature has been received from a regulatory authority (see cols. 3-4, discloses the enablement of game play at display terminals with respect to specific games as received from the central server system, where the authorization code for

enabling play with the particular feature is interpreted as the specific game play such as slots, poker, bingo, etc., as allowed by the central server system, where the central server system is interpreted as regulatory authority);

verifying, via the processor, an expiration condition for the authorization code (lacking distinguishing features, col. 10, 13-49, discloses predetermined criteria, which is interpreted as expiration conditions); and

only if the expiration condition has not yet been met, allowing play of the wagering game with the particular feature (lacking distinguishing features, col. 5, 13-25, discloses game play is allowed for the respective game as long as a time condition has not been met, in this case, the game being idle for a predetermined period of time).

50, 60, Giobbi discloses the method, wherein the expiration condition is a date on which the authorization code is no longer valid (lacking distinguishing features, col. 5, 13-25, discloses a time condition in which a game will be removed from a display terminal).

51, 61, Giobbi discloses the method, wherein the expiration condition is a maximum number of plays of the wagering game for which the authorization code is valid (lacking distinguishing features, col. 10, 13-49, discloses player preferences, where when a game is not preferred a maximum number of times for play, the game is changed or removed from a display terminal).

52, 62, Giobbi discloses the method, wherein the expiration condition is a maximum sum of wagers for which the authorization code is valid (lacking distinguishing features, col. 10, 13-49, discloses money earnings, where when a

game does not reach a maximum amount of money, the game is changed or removed from a display terminal).

53, 63, Giobbi discloses the method, further comprising: prior to allowing play of the wagering game, confirming via the processor that an authorization code disallowing play of the wagering game has not been received from the regulatory authority (lacking distinguishing features, col. 10, 13-49, where prior to showing a game on a respective display terminal the central server system inherently determines whether or not the predetermined criteria is met).

54, 55, 56, 64, 65, 66, Giobbi discloses the method further comprising: updating, via the processor, data corresponding to the expiration condition after allowing play of the wagering game, and wherein updating data comprises updating the sum of wagers placed on the wagering game based on a wager currently placed on the wagering game, and updating a number of plays of the wagering game played based on a current play of the wagering game (lacking distinguishing features, col. 2, 38-58, where the system collects game activity data, including records of wagering and game play totals).

57, 67, Giobbi discloses the method, further comprising: requesting, via the processor, a new authorization code from the regulatory authority if the expiration condition has been met (lacking distinguishing features, col. 10, 13-67, where the central server provides a new listing of games when a predetermined criteria has been met).

58, 68, Giobbi discloses the method, further comprising: purchasing the authorization code from the regulatory authority (lacking distinguishing features, col. 10, 55-67, where a player selects to play a game meets this claim limitation

because the player is paying a fee for game play where the game selected comes from the central server).

10. Claims 49-51, 53-61, and 63-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Nguyen (US 2002/0071557 A1).

Regarding claims 49, 59, Nguyen discloses **a method for facilitating play of a wagering game on a gaming device** (see Figs. 1, 3, and 4), comprising:

prior to allowing play of a wagering game including a particular feature and via a processor of a device operable to facilitate the wagering game, determining whether an authorization code for enabling play of the wagering game with the particular feature has been received from a regulatory authority (lacking distinguishing features, para. 16, discloses gaming transaction data, and para. 18, discloses game license data, where prior to game play the processor of a gaming machine determines whether game data has been received from a license server);

verifying, via the processor, an expiration condition for the authorization code (para. 18, explicitly discloses license expiration data); and

only if the expiration condition has not yet been met, allowing play of the wagering game with the particular feature (para. 18, in cases, where the expiration requirement has not been met, game play is still allowed at that the gaming device).

50, 60, Nguyen discloses the method, wherein the expiration condition is a date on which the authorization code is no longer valid (see para. 73).

51, 61, Nguyen discloses the method, wherein the expiration condition is a maximum number of plays of the wagering game for which the authorization code is valid (lacking distinguishing features, para. 48, discloses a per-use license, and para. 76, discloses game usage data).

53, 63, Nguyen discloses the method, further comprising: prior to allowing play of the wagering game, confirming via the processor that an authorization code disallowing play of the wagering game has not been received from the regulatory authority (see para. 48).

54, 64 Nguyen discloses the method further comprising: updating, via the processor, data corresponding to the expiration condition after allowing play of the wagering game (see para. 73).

55, 56, 65, 66, Nguyen discloses the method further comprising: updating, via the processor, data corresponding to the expiration condition after allowing play of the wagering game, and wherein updating data comprises updating the sum of wagers placed on the wagering game based on a wager currently placed on the wagering game, and updating a number of plays of the wagering game played based on a current play of the wagering game (lacking distinguishing features, para. 76, discloses game usage data including the number of times a gaming license has been used, including records of wagering and game play totals).

57, 67, Nguyen discloses the method, further comprising: requesting, via the processor, a new authorization code from the regulatory authority if the expiration condition has been met (lacking distinguishing features, see para. 18 and 20, where new game license data is requested).

58, 68, Nguyen discloses the method, further comprising: purchasing the authorization code from the regulatory authority (see para. 20).

Regarding claim 69, Nguyen discloses **a method for verifying play of a wagering game in accordance with a feature** (lacking distinguishing features, see paras. 48, where wagering game(s) are played in accordance with game licenses), comprising:

determining, via a processor of a computing device, that a wagering game has been mandated by a regulatory authority to only be played while a specified feature is enabled (lacking distinguishing features, see paras. 16-18, where a wagering game is open for game play when it has a corresponding game license);

receiving an authorization code from a gaming operator operating the wagering game, the authorization code indicating whether the wagering game has only been allowed to be played while the feature was enabled (lacking distinguishing features, para. 16, discloses a gaming machine receiving gaming transaction data from a remote server, where the gaming transaction data includes information pertaining to game usage, software, status, and licensing); and

verifying, by a processor and by decrypting the authorization code, that the wagering game has only been allowed to be played while the feature was enabled (lacking distinguishing features, para. 20, discloses decrypting game license request data, where a wagering game is open for game play when it has a corresponding game license).

Response to Arguments

11. Applicant's arguments filed 1/13/2010 have been fully considered but they are not persuasive.
12. Regarding applicant's remarks that none of the references of record, alone, or in combination, teach or suggest the following limitations of the new presented claims is traversed by the Examiner because the new claim limitations as presented are broad to the extent that the references of record still read on the claim limitations as demonstrated in the citations and detailed explanation provided in the above rejection remarks.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAMON PIERCE whose telephone number is (571)270-1997. The examiner can normally be reached on 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art
Unit 3714

DJP